

REMARKS

Applicants hereby request reconsideration of the present application in view of the foregoing amendments and the following remarks. The claims containing erroneously transcribed structures are presented without those errors. They are not shown as amendments, since the claims were never amended to reflect these errors in the first place. Applicants apologize for any confusion caused thereby. The recitation of specific carbohydrate moieties results from the incorporation of claim 3 into claim 1 and/or is otherwise supported by the specification at page 7, ll. 7-9. The remaining amendments improve clarity. All amendments are made solely for advancing this case toward an appeal for resolution of the pending enablement issue (see below). These amendments are not an acquiescence to the PTO's arguments, and they are not meant as a disclaimer of any subject matter. No new matter is added.

THE JUNE 7 ADVISORY ACTION

The Examiner refused to enter Applicants' prior response because of alleged new issues being raised thereby. Applicants respond point-by-point.

The Examiner first states that amendments were improperly made. This point results from an error in transcription introduced in an earlier amendment (26 October, 1998). Applicants last submission did not reflect that transcription error (neither does the present one), and instead presented the offending structure as it originally appeared in the claims. Any confusion caused thereby is regretted. Applicants, however, submit that the claim was never amended to introduce the transcription error, so they have not (re-) amended it to correct that error; the structure is merely presented in its original, never-amended form. If this is still unclear, the Examiner is requested to contact Applicants' representative, so that the appeal of this case may be expedited.

The Examiner notes at point A that the proposed amendment would yield the wrong valence for P. Applicants thank the Examiner for this helpful comment, they have addressed this point with a clearer amendment. The value of m is now clearly dependent upon the valence of X, which is well within the understanding of the skilled artisan.

Several additional formal issues relating to dependency were raised in the Examiner's point B. The noted claims have either been canceled or appropriately amended to address these concerns.

In point C the Examiner indicates that new issues are raised concerning the clarity of added claim terms. The now-objectionable terms, however, are incorporated into claim 1 from claim 3. In other words, these terms were already under consideration by the Examiner prior to the amendment at issue; that amendment, therefore, did not raise these issues. As regards the corresponding amendments to claims 15 and 20, they relate to the same terms, and Applicants cannot see how these can raise new issues either, since the Examiner has already considered them and did not raise these issues before now.

Finally, the Examiner notes that the amendments would not have addressed "points 1, 2 listed on page 2." Presumably this refers to the Office Action of November 27, 1999. It is noted, however, that point 1 relates to a transcription error that was corrected and point 2 relates to the recitation of "carboxy" in the claims (see below). Since that term is deleted in the proposed amendments, Applicants also obviated this point. If this rejection is maintained, clarification is requested.

THE NOVEMBER 27 OFFICE ACTION

Pages 2 and 3 of the Office Action provide six rejections asserted under the first and second paragraphs of section 112. Points 1 and 4 related to transcription errors introduced in Applicants last amendment to the structures. The subject claims have been re-written (not amended, since they were never amended in the first place). Points 2 and 6 are mooted by deleting the offending terminology. Point 3 is also obviated by the specific recitation of carbohydrate radicals in the independent claims. Point 5 is likewise obviated by the deletion of the structure from claim 14, which allegedly creates an improper dependency.

The only other rejection falls on claims 1-7 and 9-27 for allegedly failing to enable "how to use." Applicants intend to appeal this rejection, and thus do not treat it extensively here; they merely reiterate their previous comments, and add a couple of additional points.

One basis for this rejection is an allegation that the sole utility for the present compounds is as a lisofylline prodrug. The PTO contends, therefore, that enablement of the claims is coextensive with that single utility, and thus compounds that cannot act as lisofylline prodrugs are not enabled. While Applicants disagree with the underlying premise that the sole utility for these compounds is as prodrugs, they have amended the claims to be more in line with the Office's conception. These amendments are made solely to advance an appeal based on another aspect of the rejection: that since lisofylline is not useful for anything, Applicants'

prodrugs are not useful for anything. Moreover, Applicants attach a copy of a declaration under Rule 132, addressing this point. It is respectfully requested that the Office also consider this document in view of their arguments.

In the interest of limiting issues on appeal, Applicants respectfully request that the PTO either acknowledge this rejection as embodying the only outstanding issue or point out with particularity any remaining problems and, perhaps, suggested solutions thereto.


CONCLUSIONS

In view of the foregoing, Applicants submit that the present claims are in condition for appeal of the noted rejection as the sole issue. Should the Examiner have any questions regarding the present application or believe that further discussion will further clarify the issues, the Examiner is invited to contact the undersigned at the number listed below.

Respectfully submitted,

July 14, 1999

Date


Thomas W. MacAllister, Ph.D.
Reg. No. 42,822

FOLEY & LARDNER
Suite 500
3000 K Street, N.W.
Washington, DC 20007-5109
(202) 672-5300